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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,578

09/19/2003

Jeffrey Zhang

31132.159

6445

46333 7590 03/02/2007
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EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/665,578

Applicant(s)

ZHANG ET AL.

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on 12/15/2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. There exists an inconsistency between the language of claim 1 and that of the claim 23 dependent thereon, thus making the scope of the claim unclear. In the preamble of claim 1, line 1, applicant recites "A surgical instrument" with the prosthetic device being only functionally recited, i.e. "for extracting a prosthetic device ...", thus indicating that the claim is directed to the subcombination, "A surgical instrument". However, in claim 23, lines 1-2, applicant positively recites the prosthetic device as part of the invention, i.e. "wherein the prosthetic device has separable portions...", thus indicating that the combination, surgical instrument and prosthetic device, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-27 will be considered as being drawn to the subcombination, a surgical instrument.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-15, 17-20, and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouchi (U.S. Patent 6,206,904 B1).

Regarding claim 1, Ouchi discloses a device comprising a distal portion and a proximal portion connected to the proximal portion (reference Figure 1 below). The distal portion is capable of transitioning between an insertion configuration and an extraction configuration, wherein the distal portion has a natural bias in the extraction configuration. Regarding claim 2, Ouchi discloses a device wherein the distal portion comprises at least one engaging member. Regarding claims 3 and 4, Ouchi discloses a device wherein the engaging member is manufactured from a flexible material such as stainless steel (column 4 lines 32-34). Regarding claim 5, one definition of a block from www.dictionary.com is a solid mass of wood, stone, etc., usually with one or more flat or approximately flat faces. Using this definition, Ouchi discloses a device wherein the engaging members are secured to a mounting block. Ouchi discloses the engagement members are fastened to a solid connector tube at the basal end. Regarding claim 6, Ouchi discloses a device wherein the engaging member comprises of an extraction prong. Regarding claims 7 and 8, Ouchi

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discloses a device wherein the extraction prong comprises a transverse flange with a hook-shaped configuration. Regarding claims 9 and 10, Ouchi discloses an invention wherein the transverse flanges extend in opposing and parallel directions. Regarding claim 11, Ouchi discloses a device comprising at least one extraction prong comprising a transverse flange and a mounting portion for securing the extraction prong. The extraction prong is partially elastically deformed when in an insertion configuration. Regarding claim 12, Ouchi discloses a device wherein the extraction prong is capable of transitioning between an insertion configuration and an extraction configuration, wherein the extraction prong is in a non-deformed state when in the extraction configuration. Regarding claim 13, Ouchi discloses a device wherein the transverse flange defines a reduced transverse profile for the insertion configuration. Regarding claim 14, Ouchi discloses a device wherein the transverse flange comprises a hook-shaped configuration. Regarding claim 15, Ouchi discloses a device wherein the extraction prong is manufactured from a flexible material such as stainless steel as discussed above. Regarding claim 17, Ouchi discloses a device wherein the mounting portion comprises a mounting block as discussed above. The upper half of the mounting block can be interpreted as a connector stem capable of operably connecting the mounting block to a substantially rigid shaft. The lower half of the mounting block can be interpreted as having an axial slot capable of retaining at least one extraction prong. Regarding claims 18 and 20, Ouchi discloses a device with a distal portion comprising a transverse flange that is inherently capable of being used a method comprising the steps of

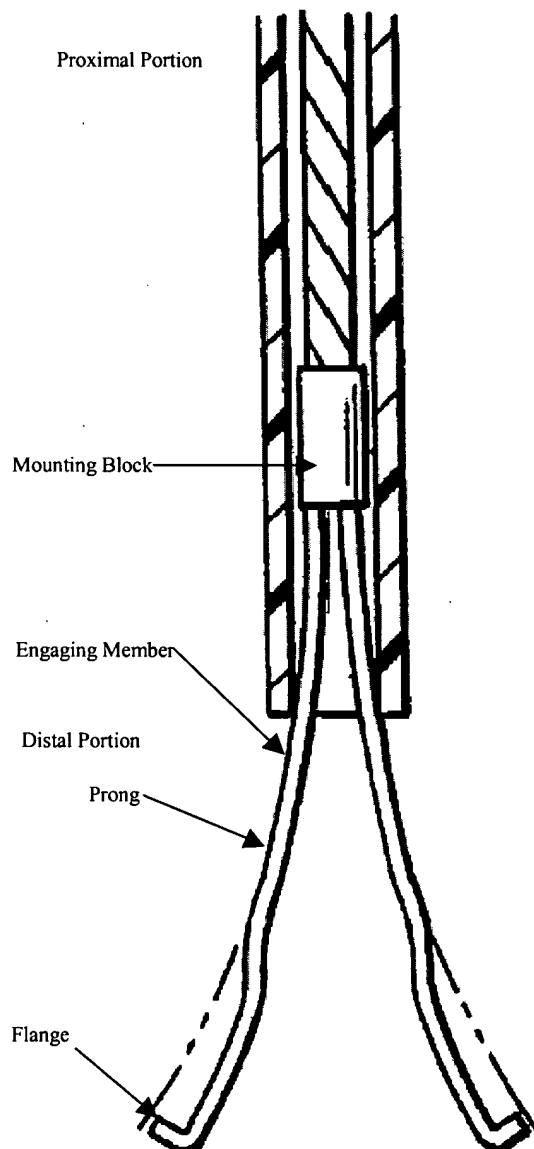
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inserting a surgical instrument having a distal portion able to transition from an insertion configuration to an extraction configuration, wherein the distal portion has a natural bias in the extraction configuration, transitioning the distal end to the extraction configuration, engaging the distal portion with an implant, and exerting an extraction force to extract the implant. Regarding claim 19, Ouchi discloses a device that is inherently capable of being used in the method of claim 18 further comprising the step of displacing the distal portion along at least a portion of the implant, wherein the insertion configuration comprises partially deforming the distal portion and wherein the distal portion is returned to the natural bias after completion of the displacement. Regarding claim 22, Ouchi discloses the device includes a control part that is connected to the proximal end of the sheath (column 3 lines 48-52) and can be interpreted as being capable of being used as a handle, since the surgeon can hold on to the instrument from the part. Regarding claim 23, Ouchi discloses a device wherein the extraction configuration is capable of exerting no separation force on a prosthetic device. Regarding claim 24, Ouchi discloses a device wherein the distal portion comprises at least two opposing extraction prongs, the at least two extraction prongs having a natural bias that defines the maximum separation of the extraction configuration. Regarding claim 25, Ouchi discloses a device wherein the distal portion is capable of maintaining opposing forces on the inner surfaces of a prosthetic device during insertion and no opposing forces on the inner surfaces of a prosthetic device during extraction. Regarding claim 26, Ouchi discloses a device wherein the distal portion is capable of extracting only one

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plate of a multi-plate articulating prosthetic device. Regarding claim 27, Ouchi discloses a device wherein the distal portion is capable of maintaining the position of one articulating plate relative to another articulating plate of a prosthetic device during insertion.

Figure 1



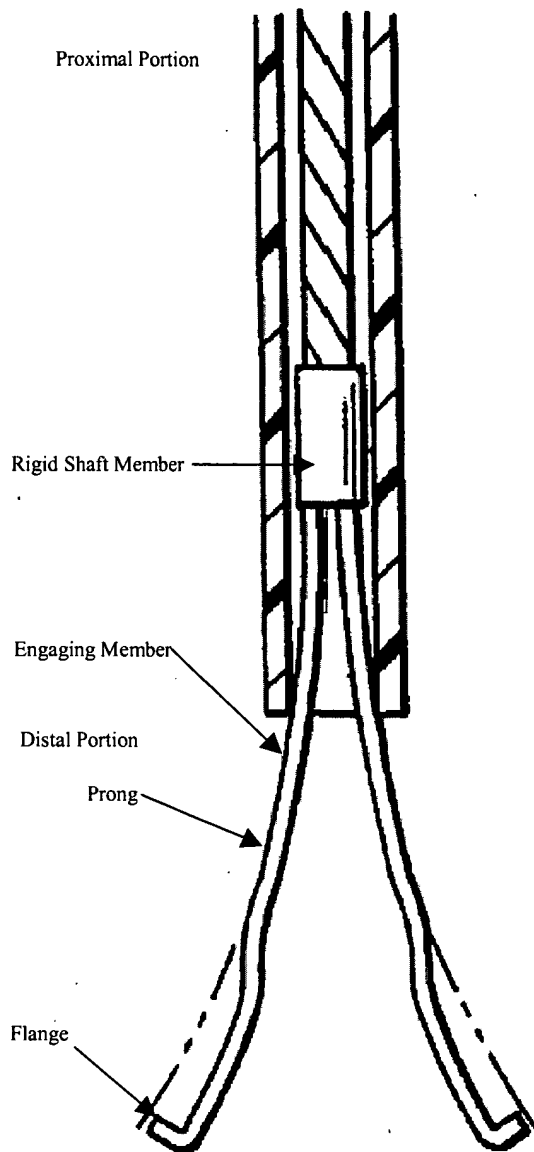
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7. Claims 1 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouchi (U.S. Patent 6,206,904 B1) as a second interpretation different from the first.

Regarding claim 1, Regarding claim 1, Ouchi discloses a device comprising a distal portion and a proximal portion connected to the proximal portion (reference Figure 2 below). The distal portion is capable of transitioning between an insertion configuration and an extraction configuration, wherein the distal portion has a natural bias in the extraction configuration. Regarding claim 21, Ouchi discloses a device further comprising a substantially rigid shaft member disposed between the distal and proximal portions.

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Figure 2



Response to Arguments

8. Applicant's arguments with respect to claims 1-15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection. The applicant added limitations to the claims that necessitated the new grounds of rejection presented by the examiner discussed above.

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Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

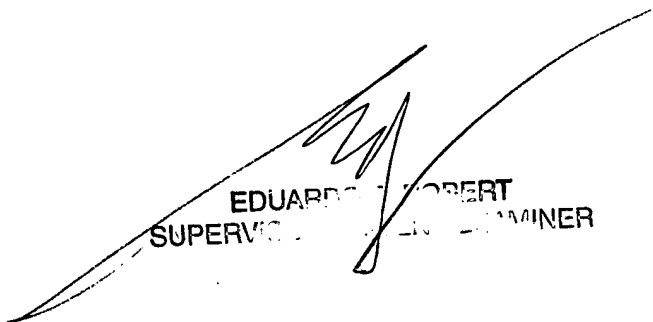
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO ROBERT
SUPERVISOR EXAMINER